

Applicants: Tilla S. Worgall and Richard J. Deckelbaum
Serial No.: 10/712,684
Filed: November 14, 2003
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REMARKS

Claims 1 and 5-16 are pending in the subject application. Applicants note that the Examiner indicated in the November 26, 2007 Office Action that claims 1-16 are pending. However, applicants note that claims 2-4 and 17-43 were canceled in a Preliminary Amendment filed November 14, 2003. Applicants have not canceled or amended any claims. Applicants also add new claims 44-49. Support for new claim 44 can be found in the specification at, *inter alia*, page 22, lines 25-30. Support for new claims 45 and 46 can be found in the specification at, *inter alia*, page 24, lines 26-31. Support for new claim 47 can be found in the specification at, *inter alia*, page 24, line 33 to page 25, line 3. Support for new claim 48 can be found in the specification at, *inter alia*, page 25, lines 5-7. Support for new claim 49 can be found in the specification at, *inter alia*, page 26, line 32 to page 27, line 9. Each of new claims 44-49 depend from claim 1 of elected Group I, and should be examined together with the claims of Group I. Applicants maintain that this Amendment raises no issue of new matter. Accordingly, upon entry of the Amendment, claims 1, 5-16 and 44-49 will be pending and under examination in the subject application.

In the November 27, 2006 Office Action, the Examiner restricted pending claims 1-16 to one of the following allegedly distinct inventions under 35 U.S.C. §121 as follows:

- I. Claims 1-12, drawn to a method of decreasing mSREBP in a cell, classified in class 514, subclass 183; and
- II. Claims 13-16, drawn to a method of increasing mSREBP in a

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cell, classified in class 514, subclass 762.

As stated above, claims 2-4 were canceled in the November 14, 2003 Preliminary Amendment. Accordingly, applicants understand that Group I corresponds to pending claims 1 and 5-12. Applicants hereinabove have also added new claims 44-49 of which claims 44-48 depend directly or indirectly from claim 1 and claim 49 related to the same subject matter, namely decreasing *de novo* synthesis of ceramide within a cell. Applicants maintain that new claims 44-49 are directed to an invention which is not independent and distinct from the subject matter of Group I.

Accordingly, applicants hereby elect Group I, claims 1 and 5-12, with traverse, as well as claims 44-49 for prosecution at this time.

In addition to the election of one of the above listed Groups, the Examiner required election of a single disclosed species. Specifically, the Examiner stated that upon election of Group I, applicants are required to define (i) a single species of agent (selected from myriocin, cycloserine, Fumonisin B1, PPMP, compound D609, methylthiodihydroceramide, propanolol or resvaratrol) and (ii) a single species of enzyme (selected from serine-palmitoyl or ceramide synthase).

In response, applicants hereby elect the agent, myriocin, and the enzyme, ceramide synthase, with traverse, for prosecution at this time. In this regard, applicants note that claims 1, 5-10, 12 and 44-49 read on these elected species.

Further, applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement. Under M.P.E.P. §803, the Examiner must examine the application on the

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merits if examination can be made without a serious burden, even if the application would include claims to distinct or independent inventions. That is, there are two criteria for a proper requirement for restriction: (1) the invention must be independent and distinct, and (2) there must be a serious burden on the Examiner if restriction were not required.

Applicants respectfully submit that there would not be a serious burden on the Examiner if restriction were not required, because a search of the art relevant to the claims of Group I would identify the relevant art for Group II. Specifically, both Groups I and II relate to methods of modulating the level of mSREBP in a cell. Since there would not be a serious burden on the Examiner to examine Groups I and II together in the same application, applicants request that the Examiner examine all of the claims pending in the application on the merits.

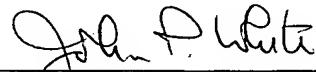
In view of the foregoing, applicant maintains that restriction is not proper under 35 U.S.C. §121, and respectfully request that the Examiner reconsider and withdraw the requirement for restriction.

No fee, other than the enclosed \$60.00 fee for a one-month extension of time, is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

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If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

Respectfully submitted,



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